

REMARKS

Claims 2, 4-6, 50-60, 70, and 71 were pending in this application.

Claims 2, 4-6, 50-60, 70, and 71 have been rejected.

Claims 2, 4-6, 50-60, 70, and 71 have been amended as shown above.

Claims 74-76 have been added.

Claims 2, 4-6, 50-60, 70, 71, and 74-76 are now pending in this application.

Reconsideration and full allowance of Claims 2, 4-6, 50-60, 70, 71, and 74-76 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 2, 4, 50-54, 70, and 71 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,339,443 to Lockwood (“*Lockwood*”). The Applicants respectfully traverse this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

The rejection of Claims 2, 4, 50-54, 70, and 71 is based on the Office Action’s interpretation

of the term “enabling” recited in Claims 2, 50, and 53. In particular, the Office Action interprets the term “enable” as a “command or condition that permits some specific condition to occur” or a “command or condition that permits some specific event to proceed.” (*Office Action, Page 2, Last paragraph*). The Office Action then asserts that an “access grant bit” of *Lockwood* is unset by one processor after that processor completes access to a shared resource, allowing other processors to access the shared resource. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*). Based on the definitions of the term “enable,” the Office Action asserts that unsetting the “access grant bit” of *Lockwood* enables access to the shared resource and therefore enables the shared resource. (*Office Action, Page 3, First paragraph*).

These definitions of the term “enable” fail to establish that *Lockwood* anticipates Claims 2, 50, and 53. According to the definitions provided in the Office Action, the term “enable” refers to any “command or condition” that permits a specific “condition” or “event” to occur or proceed. Based on these definitions, the unsetting of the “access grant bit” by one processor in *Lockwood* does “enable” access to a shared resource by another processor. However, the unsetting of the “access grant bit” only enables “access” to the shared resource. The unsetting of the “access grant bit” does not actually enable the shared resource itself. For example, unsetting the “access grant bit” does not activate the shared resource.

This distinction is actually acknowledged in the Office Action. The Office Action specifically states that the unsetting of the “access grant bit” is a command or condition that “permits another processor to access the shared resource.” (*Office Action, Page 3, First paragraph*). As a

result, the Office Action expressly acknowledges that unsetting the “access block bit” only enables “access” to the shared resource rather than actually enabling the shared resource itself.

The setting and unsetting of the “access grant bit” in *Lockwood* only enables or disables “access” to a resource and does not actually enable or disable the resource itself. In contrast, Claims 2, 50, and 53 specifically recite that “at least one access block bit” is capable of “enabling at least one of [two or more] modules.” As a result, *Lockwood* fails to anticipate these elements of Claims 2, 50, and 53.

For these reasons, the cited portion of *Lockwood* fails to anticipate the Applicants’ invention as recited in Claims 2, 50, and 53 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 2, 4, 50-54, 70, and 71.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 2, 4-6, and 50-60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,098 to Ku (“*Ku*”) in view of U.S. Patent No. 5,214,778 to Glider et al. (“*Glider*”). The Office Action rejects Claims 2, 4-6, 50-60, 70, and 71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0129184 to Watanabe (“*Watanabe*”) in view of *Glider*. The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262,

23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Once again, the rejection of Claims 2, 50, and 53 over the proposed *Ku-Glider* combination is based on the Office Action's interpretation of the term "enabling" recited in Claims 2, 50, and 53. (*Office Action, Page 3, Second paragraph*). In particular, the Office Action asserts that a "semaphore" in *Glider* is set by one portion of a system to prevent another portion of the system from accessing a shared resource. (*Office Action, Page 3, Second paragraph*). Based on the definitions of "enable," the Office Action asserts that unsetting the semaphore of *Glider* is "a command or condition that permits ... access to the shared resource." (*Office Action, Page 3, Second paragraph*).

As with the § 102 rejection, these definitions of the term "enable" fail to establish that the proposed *Ku-Glider* combination discloses, teaches, or suggests all elements of Claims 2, 50, and 53. *Glider* states that a semaphore is a variable that "indicates simply that the resource is in use." (*Col. 5, Lines 36-37*). Based on these definitions, the unsetting of the semaphore in *Glider* only "enables" access to a shared resource. The unsetting of the semaphore does not actually enable the shared resource itself. For example, unsetting the semaphore does not activate the shared resource.

This distinction is again acknowledged in the Office Action, which states that unsetting the semaphore permits "access" to the shared resource. (*Office Action, Page 3, Second paragraph*). Unsetting the semaphore does not actually enable the shared resource itself. As a result, the proposed *Ku-Glider* combination fails to disclose, teach, or suggest "at least one access block bit" that is capable of "enabling at least one of [two or more] modules" as recited in Claims 2, 50, and 53.

Similarly, the rejection of Claims 2, 50, and 53 over the proposed *Watanabe-Glider*

combination is based on the Office Action's interpretation of the term "enabling" recited in Claims 2, 50, and 53. (*Office Action, Page 3, Last paragraph – Page 4, First paragraph*). In particular, the Office Action relies on the semaphore of *Glider* as disclosing, teaching, or suggesting the "at least one access block bit" recited in Claims 2, 50, and 53.

As noted above, the unsetting of the semaphore in *Glider* only "enables" access to a shared resource, rather than enabling the shared resource itself. As a result, the proposed *Watanabe-Glider* combination fails to disclose, teach, or suggest "at least one access block bit" that is capable of "enabling at least one of [two or more] modules" as recited in Claims 2, 50, and 53.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 2, 50, and 53 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 2, 4-6, 50-60, 70, and 71.

III. NEW CLAIMS

The Applicants have added new Claims 74-76. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 74-76.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

Apr 30, 2005



William A. Munck

Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*